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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,438	12/24/2001	Richard H. Hicks	01-470-WSB	6056

7590 06/06/2003
WILLIAM S. BERNHEIM
255 N. Lincoln Street
Dixon, CA 95620

EXAMINER

MEDLEY, MARGARET B

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 06/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/029,438

Applicant(s)

HICKS ET AL.

Examiner

Margaret B. Medley

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01/07/03, 3/4/03 & 5/01/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This action is in response to Paper No. 5 dated January 7, 2003, Paper No. 7 dated March 4, 2003 and Paper No. 8 dated May 1, 2003.

The amendment to the abstract and the amendment to claims 5, 9 and 14, the addition of new claim 19 in Paper No. 7 dated March 4, 2003 have been entered of record. The pending claims of record are claims 1-19.

The requested amendments to the specification in Paper No. 5 dated January 7, 2003 has not been entered of record because it did not comply with the request for making amendments under (37 CFR 1.121) as stated in Paper No. 6 dated January 17, 2003.

The requested amendments to the specification in Paper No. 8 dated May 1, 2003 have not been entered of record because the requested amendment to page 1 of the specification in Paper No. 8, in Paper No. 5 and in the originally filed specification do not coincide. Clarification to the record is requested. Also, applicants need only to send in the paragraph or pages of the specification that have amended and not the entire specification.

In view of applicants' amendment to claims 9 and 14, the rejection under 35 USC 112 second paragraph over the term "types" is withdrawn.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 9 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 9 and 14 remain rejected under 35 U.S.C. 112, second paragraph because it is confusing that the micro-emulsion forming additive comprising a surfactant, co-surfactants, water and balance being hydrocarbon that appear to be in conflict with claim 5 that does not include hydrocarbon in the said additive. The phrase "the remaining portion is liquid hydrocarbon fuel" is broader than and is in conflict with page 9, lines 17-20 that the concentrated additive is pre-diluted with kerosene (or some other solvent/distillate).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as *** at the time this invention was made. Accordingly, *** is disqualified as prior art through 35 U.S.C. 102(f) or (g) in any rejection under 35 U.S.C. 103(a) in this application. However, this applied art additionally qualifies as prior art under another subsection of 35 U.S.C. 102 and accordingly is not disqualified as prior art under 35 U.S.C. 103(a).

Applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the invention of this application, and is therefore, not the invention "by another," or by antedating the applied art under 37 CFR 1.131.

Claims 1-8 and 19 for reasons made of record in Paper No. 2 dated September 5, 2002 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art.

Applicant makes admission on record at the first paragraph on page 3 of the instant specification that prior art Grangnette US Patent 4,396,400 teaches and discloses that namely from 100 to 5,000 ppm, preferably 100 to 1,000 ppm, water is put into an emulsion which is completely clear and very stable by means of certain specific surfactants compounds for desired improvement of a gas oil, note column 2, lines 10-19 and Example 2 of Table 1 and Example 17 of Table IV. The surfactant is 10 to 5,000 ppm, preferably 25 to 2000 ppm, surfactant; 0.5 to 1 part by co-surfactant, is column 3, lines 41-52 and column 4, lines 5-12. The surfactant includes amphoteric surfactants, column 2, lines 22 to end and anionic surfactants column 3, lines 11 to 31.

The teachings of McCoy 3,876,391, column 1, lines 49 to 58 and Wenzel 4,083,698, column 1, line 60 to column 2, lines 1-2 are incorporated into Grangette. McCoy teaches nonionic surfactants and Wenzel teaches cationic surfactants in combination with an alcohol surfactant are incorporated into hydrocarbon fuels providing stable emulsions.

The Admitted Prior Art Grangette renders the instant claim additives obvious because the lower range of 100 ppm water of Grangette suggest the upper rang of 95 ppm water of the instant claims in the absence of evidence of record to the contrary. It is the examiners position that from 0% to 25% by wt. co-surfactant read on the component not being present. When the co-surfactants is absent from the said composition, the instant claims comprises 10 to 65% by wt. water and 90 to 35% surfactants and the instant ranges are rendered obvious by the range of surfactant to water of Grangette.

Applicant's arguments filed January 7, 2003 and Richard H. Dicks Declaration dated January 7, 2003 have been fully considered but they are not persuasive.

Applicant's argument with respect to claims 1-8 not being directed to gasoline is irrelevant in that the claims are directed to an additive and is not directed to the fuel composition comprising said additive.

McCoy and Wenzel provide the motivation that the same additives used in diesel fuel emulsions e.g. gas oil, have the same functional properties in gasoline fuel emulsion providing the motivation that the fuel composition of Grangette can be used in gasoline. ~~Dicks Declaration~~ Dicks Declaration has been carefully studied. However, the declaration does not rebut the rejection made of record. Grangette clearly teaches that the quantity of the surfactant utilized is proportional to the quantity of water to be solubilized, column 3, and lines 53-54. Patentee further teaches the addition of 100 to 5,000 ppm of water, 10 to 5,000 ppm surfactant, and a co-surfactant having a weight ratio of surfactant to co-surfactant being from 0.1 to 1, column 4, lines 4-8. Grangette

range of surfactant to water rendered obvious the 0.5:1 to 8.0:1 of claims 9 and 14 and the 1.0:1 to 3:1 of claims 11 and 16 range of surfactant to water of the instant claims.

The prior art cited but not applied further teaches fuel composition and additives of the same nature of the instant claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is (703) 308-2518. The examiner can normally be reached on Monday--Friday from 7:30 a.m. to 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

M.B. Medley/dh
June 5, 2003


MARGARET MEDLEY
PRIMARY EXAMINER